

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/079,829	05/15/98	SNOW	A PROTEO.P07

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HM12/0424

EXAMINER

COE, S

ART UNIT	PAPER NUMBER
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1651

DATE MAILED:

18  
04/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/079,829

Applicant(s)

SNOW ET AL.

Examiner

Susan Coe

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 44-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 44-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

**DETAILED ACTION**

1. The amendment filed February 6, 2001, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.
2. Claims 14-43 have been cancelled.
3. Claims 44-54 have been added.
4. Claims 1-13 and 44-54 are pending.

***Claim Rejections - 35 USC § 112***

5. Claims 5, 6, 9, 47, and 50 are indefinite for the reasons set forth on page 3 of the previous Office action. These claims are considered indefinite because of the use of parentheses. Applicant argues that the claims are not indefinite because the material enclosed in the parentheses is intended to be included in the claims. However, it is still unclear when or if the material in the parentheses is to function as a limitation of the claim; therefore, the meets and bounds of the claims cannot be definitely determined. The use of the parentheses creates confusion and is improper.

***Claim Rejections - 35 USC § 102***

6. Claims 1-10, 12, 13, 44-51, 53, and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4,940,725 for the reasons set forth on page 5 of the previous Office action.

All of applicant's arguments regarding this rejection have been fully considered but are not persuasive. Applicant argues that US '725 does not anticipate the claims because this

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reference does not teach that the composition of *Uncaria tomentosa* is useful in treating the stated diseases or amyloid deposits. However, as the invention is currently claimed, the claims read on any composition that contains *Uncaria tomentosa*. US '725 readily illustrates that compositions containing this plant are known. The statement that the claimed composition is used for a different purpose is not persuasive because the claimed purposes are considered recitations of intended use. Recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant has not demonstrated a structural difference between the reference composition and the claimed composition. Applicant's claims are drawn to a composition comprising *Uncaria tomentosa* that is identical to the composition taught by US '725. Since the claimed composition and the reference composition are identical, the reference composition would inherently have to have the same effects on the human body if applicant's invention functions as claimed.

7. Claims 1-6, 9, 10, 12, 13, 44-47, 50, 51, 53, and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Stuppner et al. (Chromatographia (Dec, 1992) vol. 34, no. 11/12, pp. 597-600) for the reasons set forth on pages 5 and 6 of the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues against this reference for the same reasons

as applicant argues the 102 rejection over US '725. Please see the examiner's response to these arguments above.

***Claim Rejections - 35 USC § 103***

8. Claims 1-3, 11, 44-46, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4,940,725 for the reasons set forth on pages 6 and 7 of the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that a person of ordinary skill in the art would not be motivated to administer a composition containing 70% to 95% *Uncaria tomentosa* because the claims are novel over US '725. However, as stated above, US '725 is considered to anticipate all of the claims except claims 11 and 52. It is well established that optimizing the dosage of a known composition is obvious. This is considered to be a routine experimental parameter that would be optimized by an artisan of ordinary skill. A person of ordinary skill in the art would have been motivated to administer a composition containing 70% to 95% of *Uncaria tomentosa* because it is well known that varying dosages is a customary practice. A person of ordinary skill would reasonably expect that administering a composition with a high concentration of *Uncaria tomentosa* would increase the beneficial effects of this composition.

9. Claims 1-3, 11, 44-46, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stuppner et al for the reasons set forth on pages 7 and 8 of the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues against this reference for the same reasons

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that applicant argues the 103 rejection over US '725. Please see the examiner's response to these arguments above.

10. No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 7:30 to 5:00 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SDC

April 19, 2001



FRANCISCO PRATS  
PRIMARY EXAMINER